

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte RALPH N. MILLER,  
MALLIKARJUNA V.N. RAO, and  
STEVEN H. SWEARINGEN

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Appeal No. 2002-1584  
Application No. 09/283,449

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ON BRIEF

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Before WINTERS, ADAMS, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 10 and 26 through 28. Claims 11 through 25, which are the only other claims remaining in the application, stand withdrawn from further consideration by the examiner as drawn to a non-elected invention.

Claims 10 and 27, which are illustrative of the subject matter on appeal, read as

follows:

10. A composition comprising hydrogen fluoride in combination with an effective amount of  $\text{CF}_3\text{CClFCF}_3$  to form an azeotrope or azeotrope-like composition said composition containing from about 38.4 to 47.9 mole percent  $\text{CF}_3\text{CClFCF}_3$ .

27. A composition which consists essentially of an azeotropic combination of hydrogen fluoride with  $\text{CF}_3\text{CClFCF}_3$ .

The prior art reference relied on by the examiner is:

Webster et al. (Webster)	5,057,634	Oct. 15, 1991
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The appealed claims stand rejected as follows: (1) claim 10 under 35 U.S.C. § 102(b) as anticipated by Webster; and (2) claims 10 and 26 through 28 under 35 U.S.C. § 103 as unpatentable over Webster.

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including Figure 1 and all claims on appeal; (2) applicants' Appeal Brief (Paper No. 11); (3) the Examiner's Answer (Paper No. 12); and (4) the Webster patent.

On consideration of the record, including the above-listed materials, we reverse the examiner's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103.

#### Discussion

We shall not belabor the record with extended commentary in this case. Rather, we find it sufficient to note that each appealed claim is drawn to a composition combining hydrogen fluoride and  $\text{CF}_3\text{CClFCF}_3$ ; and that each composition is "an azeotrope or azeotrope-like composition" or consists essentially of "an azeotropic

combination."

In rejecting these claims on prior art grounds, the examiner relies heavily on Example 58 of Webster. The examiner argues that (1) the reported results of a reaction, described by Webster in Example 58, include 45.8%  $\text{CF}_3\text{CClFCF}_3$ <sup>1</sup>; and (2) "[t]he presence of HF [hydrogen fluoride] in the product is assured do [sic] to the use of an excess in the reaction and the inevitability of incomplete conversion of the starting material" (Paper No. 12, page 4, lines 12 and 13).

Conspicuous by its absence from the Examiner's Answer, however, is an adequate explanation why or how a person having ordinary skill would have arrived at the "azeotrope or azeotrope-like composition" of claims 10, 26, and 28 or the "azeotropic combination" of claim 27. It is as though the examiner finds it sufficient that Webster describes a composition containing hydrogen fluoride and  $\text{CF}_3\text{CClFCF}_3$ . But that is not enough. On the contrary, every limitation in the claims must be given effect rather than considering one in isolation from the others. In re Geerdes, 491 F.2d 1260, 1262, 180 USPQ 789, 791 (CCPA 1974). Simply stated, Example 58 of Webster constitutes insufficient evidence to support a finding of anticipation of claim 10, or to support a conclusion of obviousness of claims 10 and 26 through 28, because Webster does not disclose or suggest the "azeotrope or azeotrope-like composition" or

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<sup>1</sup> In Example 58 of Webster, the results are expressed in gas chromatograph area %.

"azeotropic combination" called for by the appealed claims.<sup>2</sup>

Accordingly, we do not sustain the rejection of claim 10 under 35 U.S.C. § 102(b) as anticipated by Webster, or the rejection of claims 10 and 26 through 28 under 35 U.S.C. § 103 as unpatentable over Webster.

The examiner's decision is reversed.<sup>3</sup>

REVERSED

Sherman D. Winters  
Administrative Patent Judge

Donald E. Adams  
Administrative Patent Judge

Eric Grimes  
Administrative Patent Judge

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E.I. Du Pont De Nemours and Company  
Legal Patent Records Center  
Barley Mill Plaza 25/1128  
4417 Lancaster Pike

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<sup>2</sup> In their specification, applicants use the terms "azeotrope," "azeotrope-like composition," and "azeotropic combination" consistent with the art-recognized meaning of those terms. Compare the specification, page 4, line 8 through page 5, line 13 with The Condensed Chemical Dictionary, 8<sup>th</sup> edition, Van Nostrand Reinhold Co., p. 86 (1971)(copy enclosed).

<sup>3</sup> Applicants also request rejoinder and allowance of withdrawn claims 11 through 25 (Appeal Brief, Paper No. 11, page 10). However, we lack authority to entertain that request. See In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473, 479 (CCPA 1971)(There are a host of decisions an examiner makes in the examination proceeding - mostly matters of a discretionary, procedural or non-substantive nature - which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims).

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